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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,812	03/18/2004	Thomas D. Smith III	4056-003	4845
7590		09/27/2006	EXAMINER	
Thomas D. Smith III		HAYES, BRET C		
7008 Landing Rd.		ART UNIT		
Oklahoma City, OK 73132		PAPER NUMBER		
		3641		

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/803,812

Applicant(s)

SMITH, THOMAS D.

Examiner

Bret Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 38-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-10 and 38-54 is/are rejected.
- 7) ☒ Claim(s) 38-40, 44 and 48-54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20 JAN 06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

For the record, as per the amendment filed 26 AUG 04, claims 11 – 37 have been canceled.

Claim Objections

1. Claims 38 – 40 & 48 – 54 are objected to because of the following informalities: the recitations of “range marker” hairlines should be --range-marker-- so as to be consistent with the base claims; claim 44, line 2, “are” should be --is--, for proper grammar (at least one...is); and, claims 50, 51, 53 & 54 should have --horizontal-- inserted between “third” (or “fourth”, as the case may be) and “range-marker” for continuity. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 5 & 38 – 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 5 & 46 recite the limitation "a dimension of the various features" in or beginning in line 1. There is insufficient antecedent basis for this limitation, the various features, in the claim. Further, it is not clear which ‘dimension’ of whichever ‘various features’ is intended to be included, as the recited ‘features’ of the reticle specifically include ‘distance-measuring and aiming indicia’, ‘orthogonally intersecting vertical and horizontal hairlines’, ‘vertical and horizontal hairlines having radially distal portions, and ‘at least two horizontal range-marker hairlines’ disposed below ‘a center horizontal hairline’. There are too many possible dimensions

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to make clear what the metes and bounds of the claims are supposed to be. As such, the examiner cannot further treat the claims on the merits.

5. Claim 41 recites the limitation "said center horizontal hairline" in line 8. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 43 recites the limitation "the intersection of said at least two range-marker hairlines with said vertical hairline" in lines 1 & 2. There is insufficient antecedent basis for this limitation in the claim. Note: there is nothing in either claim 41 or 42 to support a recitation that the range-marker hairlines intersect the vertical hairline. Further, claim 43 recites the limitation "ranges of 300 and 400", which is unclear as no unit of measure follows. 300 and 400 what?

7. Claim 45 recites the limitation "said posts" in line 2. There is insufficient antecedent basis for this limitation in the claim. Due to this ambiguity, the examiner will not be able to further treat the claim on its merits as the definition of the term "posts" is impossible to ascertain.

8. Claim 47 recites the limitations "the innermost extremities" and "said posts" in line 2. There is insufficient antecedent basis for these limitations in the claim. Due to this ambiguity, the examiner will not be able to further treat the claim on its merits as the definition of the term "posts" is impossible to ascertain.

9. Claim 48 recites the limitation "the sequential spacing" in line 2. There is insufficient antecedent basis for these limitations in the claim.

10. Any unspecified claim is rejected as being dependent upon a rejected base claim.

Claim Rejections - 35 USC § 251

11. Claims 41 – 54 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the

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present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The omitted/improperly broadened limitations of claim 41 include:

line 6, “orthogonally intersecting vertical and horizontal hairlines”, which, as set forth at pp. “a” of the ARGUMENT section of the Appeal brief, filed 21 SEP 01, define[d] applicant’s novel reticle [as] having “a center vertical hairline and a center horizontal hairline intersecting each other at a center point” (*emphasis added*);

line 7, “radially distal portions”, which, as set forth in pp. “b” of the same, define[d] applicant’s novel reticle [as] having “radially distal posts on the extremities of the hairlines with the innermost extremities on a circle[,] the center of which is the point of intersection of the hairlines” (*emphasis added*);

lines 7 & 8 of claim 41, “at least two horizontal range-marker hairlines disposed below [a] center horizontal hairline”, which, as set forth in the Remarks, filed 27 SEP 00, at page 3, pp.

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5, argues that “Applicant’s reticle involves a series of cross hair sites defined by the critical spacing of four horizontal range-marker hairlines” (*emphasis added*); and,

line 8, “[a] center horizontal hairline”, which, as set forth in pp. “b” as cited above, defines “the center of [the circle having innermost extremities thereon] is the point of intersection of the hairlines” in other words, the center horizontal hairline is bisected.

Clearly then, while omitting ‘transparent’ before ‘reticle’ or ‘straight’ before hairlines, for example, may perhaps constitute proper broadening of the claim, the omissions/broadenings indicated above were succinctly argued as defining the novelty of the claimed invention and are improperly broaden the claim.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 41 – 43 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent Nr. 3,948,587 to Rubbert.

14. Re – claim 41, Rubbert discloses the claimed invention including in a telescopic gunsight having an optical system comprised of a forward objective lens element, a rear eyepiece lens element and an intervening erector lens element, all of which are seen in FIG. 5, for example, said elements being aligned upon an optical axis constituting a line of sight, also as seen in FIG. 5, for example, and protectively confined within an elongated tubular housing, as set forth at the description of the drawings 6 – 8 and 13 – 15, “power scopes of the type shown in FIG. 5”, for

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example, the improvement comprising the addition into said optical system between said objective and erector lens elements of a reticle, as seen in FIGS. 1 & 2, for example, having distance-measuring and aiming indicia 1, 3, 5, 7 & 9, for example, said indicia comprising orthogonally intersecting vertical 1 and horizontal 3 hairlines, said vertical and horizontal hairlines having radially distal portions, as seen in FIGS. 1 & 2, for example, and at least two horizontal range-marker hairlines 5, 7 & 9, for example, disposed below [a] center horizontal hairline.

15. Re – claim 42, Rubbert further discloses wherein the intersection of the vertical and horizontal hairlines constitutes a center point, which defines a bullet impact point. Not to be flippant, but that is the main idea of reticules: to define a bullet impact point.

16. Re – claim 43, Rubbert discloses the claimed invention including wherein the intersection of said at least two range-marker hairlines 5 & 7, for example, with said vertical hairline 1 constitute at least first and second bullet impact points, respectively at ranges of 300 and 400, respectively. In light of the ambiguity triggering the 112, 2nd rejection above, Rubbert anticipates the claim because the intersection of the at least two range-marker hairlines with the vertical hairline inherently constitute first and second bullet impact points, respectively, at ranges of 300 and 400 (units of measure), respectively, Rubbert not proclaiming such notwithstanding.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubbert in view of US Patent Nr. 5,181,323 to Cooper.

19. Rubbert discloses the invention substantially as claimed as applied above except for at least one of said radially distal portions of said vertical and horizontal hairlines is widened.

20. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubbert in view of US Patent Nr. 1,708,3898 to Karnes.

21. Rubbert discloses the invention substantially as claimed as applied above except for wherein distances of separation of said range-marker hairlines from a center point are such as to cause sequential spacing between said range-marker hairlines to progressively increase. Karnes teaches a reticule glass, as seen in FIG. 1, for example, wherein distances of separation of said range-marker hairlines **E** from a center point are such as to cause sequential spacing between said range-marker hairlines to progressively increase in the same field of endeavor for the purpose of marking off distances based upon predicted ballistic trajectories. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rubbert to include progressively increasing spacing between the range-marker hairlines in order to better suit the predicted ballistic trajectories. While it could be argued that Karnes does not clearly teach the sequential spacing between the hairlines as beginning at the center, it would not overburden one of ordinary skill in the art at the time the invention was made because to do so would require merely doing as that which is represented from the 1000 yard hairline and below, a progressively-increasing spacing between the hairlines, to be above that 1000 yard hairline and up to the center, and, thus, provide progressively-increasing spacing from the center.

Allowable Subject Matter

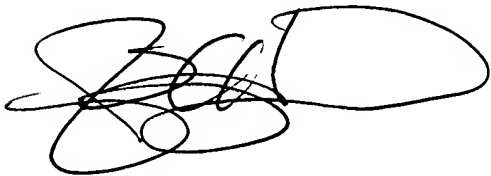
22. Claims 1 – 4 are allowed.
23. Claims 5 – 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
24. Claims 49 – 54 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, and 35 U.S.C. 251, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims also overcoming such rejections.

Conclusion

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (571) 272 – 6902 or email address bret.hayes@uspto.gov. The examiner can normally be reached Monday through Thursday from 5:30 am to 4:00 pm, Eastern Standard Time.

The Central FAX Number is **571-273-8300**.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached at (571) 272 – 6873.

A handwritten signature in black ink, appearing to be 'Bret Hayes', with a large, stylized loop at the end.

Bret Hayes

23-Sep-06